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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,336	05/04/2001	Shinichi Suwabe	040405/0337	6759
22428	7590	04/20/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				BEKERMAN, MICHAEL
		ART UNIT		PAPER NUMBER
		3622		

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/848,336	SUWABE, SHINICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 February 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 February 2006 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

This action is responsive to papers filed on 2/2/2006.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 3, 13, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 3, 13, and 23, they recite the limitation "respective detailed information". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 3, 11, 13, 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter (U.S. Pub No. 2002/0156858).** Hunter teaches an information

advertisement panel system that includes all of the limitations recited in the above claims.

**Regarding claims 1, 3, 11, 13, 21, and 23,** Hunter teaches a plurality of shop terminals configured to connect to a server (via the internet) and send an advertisement to be displayed on an advertisement panel device (the computer that connects to the internet is taken to be a shop terminal) (Paragraph 0016). Hunter also teaches an advertisement panel control terminal (server) that is configured to receive, register, and store advertisement and control information (when the advertisement is shown), and is also configured to determine a panel device to show the advertisement on and controls the display of the advertisement on the panel device (Paragraphs 0016-0017).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Pub No. 2002/0156858) in view of Amo (U.S. Patent No. 5,844,181).**

**Regarding claims 2, 12, and 22,** Hunter doesn't specify that there is an updating feature associated with the panel display system. Amo teaches an information display system having a remote control center (advertisement updating unit) that

transmits advertisement updates to a display (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to send updated advertisements to the server in case a sale changes or a correction needs to be made.

**4. Claims 4, 6-10, 14, 16-20, 24, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Pub No. 2002/0156858) in view of Avnet (U.S. Pub No. 2002/0094787).** Any information contained within Avnet that is relied upon in this action is also contained in provisional application 60/196,756.

**Regarding claims 4, 6, 14, 16, 24, and 26,** Hunter teaches a plurality of shop terminals configured to connect to a server (via the internet) and send an advertisement to be displayed on an advertisement panel device (the computer that connects to the internet is taken to be a shop terminal) (Paragraph 0016). Hunter also teaches an advertisement panel control terminal (server) that is configured to receive, register, and store advertisement and control information (when the advertisement is shown), and is also configured to determine a panel device to show the advertisement on and controls the display of the advertisement on the panel device (Paragraphs 0016-0017). Hunter doesn't teach the panel device as communicating with an information portable unit. Avnet teaches sending detailed information (movie description, reviews, video, or audio) about a billboard display from the billboard to a user's PDA (Paragraph 0014). It would have been obvious to one having ordinary skill in the art at the time the invention was

made to allow a user to interact with a billboard panel device. This would allow the user to gather more information about the information displayed in an easy, efficient manner.

**Regarding claims 7, 8, 10, 17, 18, 20, 27, 28, and 30,** Hunter teaches the sending of information from an advertisement panel control terminal (server) to a billboard panel device. Avnet teaches the sending of detailed information consisting of a plurality of items (movie description, reviews, video, or audio) from a billboard to a PDA. While Avnet teaches multiple items as being sent, neither Hunter nor Avnet specify an item list as being sent from the billboard to the portable device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to send a list to the portable device that would give the user a choice of what to view, rather than sending all of the detailed information at the same time. This would make it easier for the user to comprehend all of the information (it would be difficult to watch multiple videos and read a movie review all at the same time). Avnet also teaches ordering tickets (a reservation for a movie) through the PDA connected to the billboard. An updating of reservation state (showing a purchased ticket) must inherently take place.

**Regarding claims 9, 19, and 29,** Hunter teaches a Billing and Report Generation module for measuring, (inherently) updating, and reporting traffic history and advertisement content for the advertisement (Paragraph 0030). Avnet teaches receiving multiple items from the billboard through a PDA. Neither Hunter nor Avnet specify storing an access history for each specific item downloaded, however since Hunter does measure traffic and content of advertisements, it would have been obvious

to one having ordinary skill in the art at the time the invention was made to keep track of exactly which detailed information was downloaded. This would allow advertisers to keep track of not only how many people have seen the advertisement, but also which information pertaining to the advertisement has been downloaded most. This information can also be useful for billing purposes (as seen in Hunter).

5. **Claims 5, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (U.S. Pub No. 2002/0156858) in view of Avnet (U.S. Pub No. 2002/0094787), and further in view of Amo (U.S. Patent No. 5,844,181).**

Regarding claims 5, 15, and 25, neither Hunter nor Avnet specifies that there is an updating feature associated with the billboard panel display system. Amo teaches an information display system having a remote control center (advertisement updating unit) that transmits advertisement updates to a display (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow users to send updated advertisements to the server in case a sale changes or a correction needs to be made.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER

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